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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/423,606	11/12/1999	KAZUTAKA HAYASHI	3114-0025-0X	6947

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

NOLAN, SANDRA M

ART UNIT PAPER NUMBER

1772

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/423,606

Applicant(s)

HAYASHI ET AL.

Examiner

Sandra M. Nolan

Art Unit

1772

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: (See the attachment.).
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 1-3,6,23 and 24.Claim(s) withdrawn from consideration: 7-21.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ATTACHMENT TO ADVISORY ACTION

Claims

1. Claims 1-3, 6-21 and 23-24 are pending, with claims 7-21 withdrawn.
Claims 4, 5, and 22 have been cancelled.

Entry of Proposed Amendment upon Appeal

2. Upon appeal, the amendments proposed in the 23 February 2004 response will be entered. See the enclosed copy of the first page of that response.

Withdrawal of Claim Objections after Entry of Proposed Amendment

3. Upon entry of the amendment proposed in the 23 February 2004 response, the objection to the claims recited in section 3 of the 14 November 2003 office action (formerly Paper No. 19), will be withdrawn.

Response to Arguments

4. Applicant's arguments filed in the 23 February 2004 response have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show a certain feature of applicant's invention, it is noted that the feature upon which applicant relies (i.e., the use of a polymerizable siloxane (1) and a nonpolymerizable siloxane (2)) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification, even if present therein, are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Applicants point out at least nine (9) times that one or more of the references does not teach the combination of a polymerizable siloxane and a nonpolymerizable one. However, the claims do not recite the use of this combination of reagents.

The examiner notes that applicants argue, on page 11, first full paragraph of the 23 February 2004 response, that this combination is a "claim limitation" [quoted from page 11, lines 4-5 of the 23 February 2004 response.].

However, the combination argued/discussed throughout the 23 February 2004 response is not presently claimed. See MPEP 2145(VI).

Note: Amending the instant finally rejected claims to recite the combination of a polymerizable siloxane and a nonpolymerizable siloxane:

- (a) would introduce at least one new issue into the claims, and
- (b) could be the basis for one or more new matter rejections.

Conclusion

Any inquiry concerning this communication should be directed to Sandra M. Nolan, whose telephone number is 571/272-1495. She can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time. If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498. The fax number for patent application documents is 703/872-9306.



S. M. Nolan
Primary Examiner
Technology Center 1700